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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,544	02/06/2001	Thomas Dietz	14186	7213

7590                    01/29/2002

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[REDACTED] EXAMINER

WILLIS, MICHAEL A

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

1617

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/777,544	DIETZ ET AL.
	Examiner Michael A. Willis	Art Unit 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 June 2001.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

Claims 1-11 are pending.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 5-8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 2 is rejected for being confusing due to the phrase "cosmetic or pharmaceutical oil-in-water of Claim 1". The phrase appears to be missing a term after "oil-in-water". Correction is required.

4. Claim 2 is rejected for being vague due to the phrase "customary auxiliaries". It is not clear what is meant by the phrase. It is not clear which auxiliaries would be customary to add to the claimed composition.

5. Claim 8 is rejected for lack of antecedent basis for the phrase "said portion". The rejection can be obviated by substitution of the phrase "said proportion".

6. Claim 10 is rejected for being unclear due to the phrase "free from silicone-like oil components". It is not clear what silicone-like oil components are. It is not clear if the phrase includes only silicone-containing compounds or if non-silicone containing compounds can also be included.

7. Any remaining claims are rejected for depending from an indefinite base claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bolich, Jr. et al (US Pat. 5,965,115). Bolich discloses personal care compositions. The compositions are comprised of from about 0.01% to about 10% of a silicone-linear polyoxyalkylene block copolymer surfactant (see abstract). The silicone - polyoxyalkylene copolymer surfactant provides for improved stability of the polyorganosiloxane emulsion (see abstract and col. 1, line 4 through col. 2, line 54). A particularly preferred silicone polyether is disclosed as having terminal polyether groups, commercially available under the tradename TEGOPREN 5830 (see col. 11, lines 18-63). The proportion of silicone content in TEGOPREN 5830 is 55% (see col. 11, lines 40-63). The examples include formulations with TEGOPREN 5830 (see col. 30, line 46 through col. 36, line 51). Additional formulations include stearate salt and silicone microemulsion containing coemulsifiers (example XVI), and perfume oil (example XXII).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolich, Jr. et al (US Pat. 5,965,115). Bolich teaches the use of silicone-linear polyoxyalkylene block copolymers in personal care compositions (see abstract). The silicone-polyoxyalkylene copolymers are used for their surfactant properties (see col. 9, line 47 through col. 11, line 63). The silicone polyethers are suitable when they are surface active in the solvent system employed. Bolich teaches that the surface activity depends on the molecular weight of the polymeric portion comprising repeating organosiloxane units (see col. 9, lines 50-65). The organosiloxane portion should be sufficiently large so that it is insoluble in the carrier, yet not so large that it renders the whole molecule insoluble in the carrier (see col. 9, lines 50-65). Particularly preferred silicone polyethers are those having the formula taught in col. 11, lines 18-35. Bolich teaches that compositions with the silicone polyethers will optionally contain a variety of other ingredients such as are conventionally used in personal care products (see col.

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14, line 24 through col. 27, line 50). The reference lacks disclosed examples of the entire scope of the instant claims.

13. It would have been obvious to one of ordinary skill in the art to have modified the silicone polyethers taught by Bolich by varying both the silicone and polyether portions in order to benefit from copolymers with silicone portions that are sufficiently large so that it is insoluble in the carrier, yet not so large that it renders the whole molecule insoluble in the carrier, as taught by Bolich. The benefit of the modification is optimization of surfactant properties.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

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*Michael A. Willis*

Michael A. Willis  
Examiner  
Art Unit 1617

January 28, 2002

*Michael G. Hartley*

MICHAEL G. HARTLEY  
PRIMARY EXAMINER